

REMARKS

The Pending Claims

Currently pending are independent claims 1 and 16 as well as dependent claims 2-15 and 17-30. The pending claims are directed to a container including multiple side seals and a closure device and a method of manufacturing such a container. Reconsideration of the pending claims is respectfully requested.

Summary of the Office Action

The Office Action rejects claims 1-8, 15-23, and 30 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,007,143 (Herrington) in view of U.S. Patent No. 3,578,239 (Perlman). The Office Action also rejects claims 9-11 and 24-26 as obvious over Herrington and Perlman in further view of U.S. Patent No. 6,190,043 (Diplock). Claims 12 and 27 are rejected as obvious over Herrington and Perlman as combined in further view of U.S. Patent 5,871,281 (Stolmeier). Claims 13 and 28 are rejected as obvious over Herrington and Perlman in further view of U.S. Patent 3,806,998 (Laguerre). Finally, the Office Action rejects as obvious claims 14 and 29 over Herrington and Perlman in further view of U.S. Patent No. 5,664,229 (Porchia).

Discussion of the Prior Art Rejections

Herrington and Perlman are nonanalogous art and should not be combined. First, the patent classifications for these patents are different. PTO classification is some evidence of analogy. See M.P.E.P. 2141.01(a). In addition, Herrington and Perlman have differences in structure and function. Herrington discloses a plastic bag having a reclosable fastener. Perlman, at best, discloses a single use heat shrinkable bag for packaging and cooking food. Thus, Herrington and Perlman differ in structure and function as described herein. Therefore, Herrington and Perlman are nonanalogous and should not be combined.

To reject a claim as obvious over a combination of references, there must be a suggestion or motivation to combine the references, there must be a reasonable expectation of success, and the references as combined must teach or suggest all of the claimed limitations. See, e.g., M.P.E.P. § 2143. The mere fact that claimed elements can be found in prior art references or that those references can be combined is insufficient to establish an obviousness rejection if the prior art does not provide the suggestion or motivation. See, e.g., M.P.E.P. § 2143.01. The suggestion or motivation must come from the prior art and not from the applicant's disclosure. M.P.E.P. § 2143. Hindsight reconstruction of the applicant's

invention from the prior art references is impermissible. See, e.g., *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

As stated by the Federal Circuit in *Northern Telecom Inc. v. Datapoint Corp.*, 15 U.S.P.Q.2d 1321, 1323 (Fed. Cir. 1990):

It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1988) (insufficient to select from the prior art the separate components of the inventor's combination, using the blue print supplied by the inventor); *Rosemount Inc. v. Beckman Instrument, Inc.*, 727 F.2d 1540, 1546, 221 U.S.P.Q. 1, 7 (Fed. Cir. 1984) ("As this court has held, 'a combination may be patentable whether it be composed of elements all new, partly new or all old'"); (citations omitted); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (individual references can not be "employed as a mosaic to recreate a facsimile of the claimed invention.")

Applicant respectfully submits that his claimed invention is patentable over the cited combinations of references for the reason that no suggestion or motivation exists for the combination set forth in the Office Action. The invention as claimed is, *inter alia*, a container having in combination first and second sidewalls with first and second fastening strips configured to occlude and deocclude the container, a first side seal along a first edge joining the sidewalls, a second side seal along a second edge, and a third side seal disposed along the first side seal. Consideration of obviousness of the invention must be directed to the claimed invention as a whole, i.e., a container with multiple side seals for improved joining of the sidewalls that can be opened and closed using the fastening strips. See, e.g., M.P.E.P. § 2141.02.

Herrington (U.S. 5,007,143) discloses a plastic bag having a plastic reclosable fastener that includes a pair of flexible plastic strips with complementary male and female elements disposed along a top edge of the bag and a movable slider straddling the strips for opening and closing the elements. See, e.g., column 2, line 43 – column 3, line 4. As the Office Action points out, Herrington does disclose at column 4, lines 53-56 that the plastic bag is formed from a pair of flexible plastic sheets. Moreover, one of skill in the art would recognize that the plastic sheets need to be joined together along the side edges to produce a plastic bag. However, absent in Herrington is any discussion of how the side edges are to be joined nor is there disclosed any structure for accomplishing such joinder. Herrington also does not disclose or suggest that prior art joining structures are deficient or otherwise require improvement, nor does Herrington suggest how to improve such joining structures.

Perlman (U.S. 3,578,239) concerns a heat shrinkable plastic bag for packaging and distributing food items such as frozen turkeys. See, e.g., Abstract. To enable the bag to absorb shock during loading and to accommodate stresses developed during heat shrinking without tearing, the bag includes two adhesive bands at an edge, one band demonstrating relative strength and the other "peelability" or separability. See, e.g., column 1, line 73 – column 2, line 10 and column 2, lines 31-42. The bag also includes an open end for loading that can be closed by a metal or plastic clip. See, e.g., column 3, lines 43-50. The contained food product can then be cooked within the Perlman bag. Presumably, the clip can withstand temperatures encountered during shrinkwrapping and cooking.

There is no suggestion or motivation to combine the adhesive bands of Perlman with the reclosable fastening strips of Herrington. Perlman, at best, discloses a single use heat shrinkable bag for packaging and cooking food items. The open end of the Perlman bag is closed by a clip. There is no suggestion or motivation to employ the two adhesive bands of Perlman with a flexible plastic bag having reclosable fastening strips. The Office Action is incorrect in its contention that the method of closing the Perlman bag is irrelevant because that feature is not relied on. An obviousness inquiry requires consideration of the prior art reference in its entirety, including those portions that would lead away from the claimed invention. See, e.g., M.P.E.P § 2141.02.

Because Herrington lacks any suggestion to improve the side seals of a flexible plastic bag, and Perlman lacks any suggestion to utilize interlocking fastening strips for opening and closing a bag, those references cannot be combined to arrive at a container having first and second fastening strips, a first side seal disposed along a first edge, and a third side seal disposed along the first side seal.

The Office Action states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of multiple side seals to the bag of Herrington in view of Perlman." However, the fact that a claimed invention is within the capabilities of one of ordinary skill is insufficient to establish an obviousness rejection. See, e.g., M.P.E.P. § 2143.01 (*citing Ex Parte Levingood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993) ("A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references."))

The Office Action also conclusorily implies that applying the references together is obvious because "doing so provides a more secure sealing arrangement at the bag side walls."

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The Office Action provides no evidence for this other than stating that it "would have been obvious to one of the ordinary skill in the art." It is not appropriate to rely upon common knowledge to establish the principle basis for a rejection without concrete evidentiary support. See, e.g., M.P.E.P. § 2144.03. The Office Action provides no reason for particularly selecting multiple side seals for use with a bag having reclosable fastening strips.

Accordingly, Applicant respectfully submits that independent claims 1 and 16 are patentable over the cited combination of references. Furthermore, claims dependent upon a claim that is not obvious cannot be rejected under 35 U.S.C. § 103. See, e.g., *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Because independent claims 1 and 16 are not obvious in view of the prior art, the obviousness rejections of dependent claims 2-15 and 17-30 should likewise be withdrawn.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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